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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,252	10/20/2003	Jeffrey S. Malkin	19504-008001	3426
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			EXAMINER MANOHARAN, MUTHUSWAMY GANAPATHY	
			ART UNIT 2617	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/690,252

Applicant(s)

MALKIN ET AL.

Examiner

Muthuswamy G. Manoharan

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-12 and 17-20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-12 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollstrom in view of Hoisko et al. (hereinafter Hoisko) (U.S. 2002/0082007), FA (Fisher et al. (hereinafter Fisher) (US 5694562) or Allport (US 2002/0135619)) and Kovales et al. (US 7003083).**

Regarding **claim 1**, Hollstrom discloses a device for inserting sound segments into a voice channel carrying a voice stream of a voice transmission communication device (item 27 in Figure 3; Paragraph [0046], line 5), comprising:

a communications interface configured to establish a voice channel ("mobile telephone", Abstract);

a mixer (item 30, Figure 3; Paragraph [0046], line 3) configured to couple with the audio channel (item 29 in Figure 3, Paragraph [0046], line 6), to receive a selected sound segment in response to a trigger activation and to inject the selected sound segment into the voice channel, the voice channel contemporaneously carrying the selected sound segment and voice stream as a single output stream (Paragraph [0013], lines 1-10).

Hollstrom did not teach expressly a client controller structured and arranged:  
to store two or more catalogs, each catalog including two or more different sound segments,  
to receive instructions that a particular catalog has been selected, and  
to load the selected catalog,  
a display configured to present a menu associated with two or more different sound segments within the selected catalog loaded by the client controller;  
the two or more different sound segments within the catalog loaded by the client controller, the sound segment to be carried within the voice channel, the voice channel carries the voice data.

However, Hoisko teaches in an analogous art, a client controller structured and arranged to:

store two or more catalogs(20a, 20b, ...20n), each catalog including two or more sound segments (10a,10b, ...10n) (For each effective state (could represent a catalog) in the menu directory may also contain several musical compositions; several musical compositions are associated with the selected effective state; Paragraph [0019]);

receive instructions that a particular catalog has been selected ("the user of the phone selects in the menu effective state"; Note: **For each effective state there corresponds a particular catalog with set of musical compositions**, Paragraph 0017); and

to load the selected catalog ("**on the basis of the identifier a suitable musical composition 10a, 10b, ... 10n is searched in the directory in the cell phone of the called party**", "**right musical combination is fetched from the directory**", Paragraph [0027-0028]);

a display ("display", Paragraph [0017]) configured to present a menu associated with two or more different sound segments within the selected catalog loaded by the client controller (browse the menu using the phone's keypad", Paragraph [0017]);

the two or more different sound segments within the catalog loaded by the client controller, the sound segment to be carried within the voice channel, the voice channel carries the voice data (Paragraph [0017], lines 5-11; Paragraph [0018-0019]; user of the phone may select the effective state (requires a trigger button) and background music (requires another trigger button), Paragraph [0019], lines 26-27; "a cellular phone may be programmed so as to include a function ... by pressing a key on the phone", Paragraph [0025], lines 10-13).

Therefore, it would have been obvious to one of ordinary skill in the art to at the time of the invention to have a client controller structured and arranged to:

store two or more catalogs, each catalog including two or more sound segments;  
receive instructions that a particular catalog has been selected; and

to load the sound segments with in the selected catalog the selected catalog;  
a display configured to present a menu associated with two or more different  
sound segments within the selected catalog loaded by the client controller;  
a communications interface configured to establish a voice channel;  
the two or more different sound segments within the catalog loaded by the client  
controller, the sound segment to be carried within the voice channel, the voice channel  
carries the voice data

The combinations of Hollstrom and Hoisko did not teach specifically multiple  
sound trigger buttons on a handset become programmed to each correspond to a  
specific sound segment within the selected catalog. However, FA (Fisher or Allport)  
teaches in an analogous art multiple sound trigger buttons on a handset become  
programmed to each correspond to a specific sound segment within the selected  
catalog (**Fisher**: Figure 2; Col. 2, lines 15-25; **Allport**: Figure 1, Paragraph [0016] ).  
Therefore, it would be obvious to one of ordinary skill in the art at the time of invention  
to use the multiple sound trigger buttons on a handset become programmed to each  
correspond to a specific sound segment within the selected catalog in order to have an  
alternate way of function selection instead of menu and arrow keys.

The combinations of Hollstrom, Hoisko and Fisher did not teach specifically  
trigger activation during an ongoing communication over the voice channel. However,  
Kovales teaches in an analogous art, trigger activation during an ongoing  
communication over the voice channel ("**the mixing may occur within a telephone  
conversation**", Abstract, lines 5-6). Therefore, it would be obvious to one of ordinary

skill in the art, the trigger activation during an ongoing communication over the voice channel. This modification provides flexibility to the user in selecting the functionality for the selection buttons and also provides additional flexibility in choosing the time of trigger.

Regarding **claim 2**, Hollstrom discloses the device of claim 1, further comprising a sound encoder (Paragraph [0046], lines 13) configured to receive the sound segment from a source external (Paragraph [0036], lines 4-5) to the device.

Regarding **claim 3**, Hollstrom discloses the device of claim 2, wherein the sound segment comprises a file format comprising one form a group consisting of an MP3 file format, a WAVE file format, and an audio video interleave tile format (Paragraph [0035], lines 1-3).

Regarding **claim 4**, Hollstrom discloses the device of claim 1, further comprising a communications device interface (Figure 1, item 8; paragraph [0031], lines 1-3) for coupling with a communication device (Figure 3, item 27, items 30, 31, 29).

**Claims 5-8** are rejected for the same reason as set forth in claims 1-4 respectively.

**Claims 9-12** are rejected for the same reason as set forth in claims 1-4 respectively.

Regarding **claim 17**, Kovales further teaches two or more triggers adapted to be activated in response to a user input during a time period after a call initiating party and a call receiving party have begun conversation ("the mixing may occur within a telephone conversation", Abstract, lines 5-6).

**Claims 18 and 19** are rejected for the same reasons as set forth in claim 17.

Regarding **claim 20**, Kovals further teaches, wherein selecting, in response to the user input reflecting activation of the sound trigger button during the ongoing communication over the established voice channel includes selecting, in response to the user input reflecting activation of the sound trigger button during the ongoing communication after the voice channel is established ("the mixing may occur within a telephone conversation", Abstract, lines 5-6).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Muthuswamy G. Manoharan whose telephone number is 571-272-5515. The examiner can normally be reached on 7:00AM-2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eng George can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
GEORGE ENG  
SUPERVISORY PATENT EXAMINER